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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,335	11/06/2003	James W. Scott	5490-000366	7916
27572	7590	03/19/2008		
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/702,335

Applicant(s)

SCOTT ET AL.

Examiner

JAMES L. SWIGER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12, 14-19 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 14-19 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/6/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Finality

The finality of the previous action dated 8/24/2007 has been withdrawn. The effective date of the claims for examination purposes is 6/4/2007.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fact that the handle is claimed as "removably coupled" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, 12, 18, and 27-31 rejected under 35 U.S.C. 102(e) as being anticipated by Heldreth et al. (US Patent 6,942,670). Heldreth et al. discloses an apparatus for aiding in the preparation of the tibia having a tibial base (12) that has a center axis, a handle (14) that has a longitudinal axis that is also coaxial with the axis of the tibial base, and wherein the handle is considered coupled via links 22 to the base location. With regards to the links 22 which provide a removably coupled connection, these connections are considered *offset* the center axis. This handle and connection is capable of being reversible because of the structure present. In regards to pin 24, which IS on the central axis (in contrast to the handle being attached at a location "ONLY" offset) this pin is NOT considered significant in the connection of the handle to the base. the pin by itself is not a securing element, per se, but rather is regarded as more of a guidance device to help the links (22) to remain in their coupled state in use of the device. The base itself is also considered at least a template, and the offset connections

may be considered medial in orientation depending on the use of the device. Each link is further considered to have two ends, one which connects to the handle and the other which touches the base at a location in the bores (26). These links may be considered integral to the handle, shown in Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 14, 16-17, 19 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heldreth et al.'670 in view of Klein. Heldreth et al. discloses the claimed apparatus except for, more specifically, a cut out portion that is offset relative to the base and handle and provides clearance when using the device between the head and handle portion. Klein discloses a tool a gauging/measuring/preparation tool that has a head portion (defined at the base of A2 and above) connected by an offset link portion (the curved connection portion) and a handle (at approx A3 and downward). The design of the device is such that the head allows for clearance when using the device between the head and handle. The connection is offset, and provides a cutout on the one side. See Col. 2, lines 75-90: the design allows for placement of the tape, or at least improved access to the desired area with the cutout. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device

of Heldreth et al. having at least a cutout as taught by Klein to allow better access when using the device.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heldreth et al. '670 in view of Schmidt (US Patent 3,203,285). Heldreth et al. discloses the claimed invention except for a link portion that is detachable from the head and handle portion. Schmidt discloses a device that has a head and handle portions. It is noted that the head and handle portions are capable of being arranged so that the head portion and handle are coaxial. Additionally, one of the links (13) can be offset and can also be removably coupled to the base and handle, respectively. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Heldreth et al. having at least a removably coupled link in view of Schmidt to have better access from a side between a head and handle.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heldreth et al. '670. Heldreth et al. discloses the claimed invention except for the link, handle, and base being integral with each other. With regard to the parts being integral, it is noted that Heldreth discloses the parts which may be secured together as a rigid unit. Therefore, the constituent parts are so combined as to constitute a unitary whole or structure, or one wherein the parts are integral. In re Larson, 144 USPQ 347 (CCPA 1965).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heldreth et al. Heldreth et al. disclose the claimed invention except for the linked portion being set from the central axis at angles. It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to construct the offset portion at an angle between 15 and 45 degrees to the axis of the base, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, and as in this case, to provide adequate space between the head and handle. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 8-12, 14-19 and 27-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733